

REMARKS

This is a full and timely response to the final Official Action mailed **February 16, 2005**. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, various claims have been amended. No claims are added. Claim 2 has been cancelled. Claims 22-30 were withdrawn from consideration under a previous Restriction Requirement. Claims 42 and 43 were withdrawn in the final Action. Thus, claims 1, 3-21 and 31-41 are currently pending for the further action.

Allowable Subject Matter:

In the outstanding Office Action, the Examiner allowed claims 12-14 and 33. The Examiner further indicated the presence of allowable subject matter in claims 2, 34 and 35. Applicant wishes to thank the Examiner for the allowance of claims 12-14 and 33 and the indication of allowable subject matter in claims 2, 34 and 35.

Consequently, claim 34 has been amended herein and rewritten as an independent claim. Additionally, the allowable subject matter of claim 2 has been added to claim 1 and claim 2 cancelled. Therefore, based on the Examiner's identification of allowable subject matter, claims 1, 3, 6-10, 34, 35 and 40 should be in condition for allowance following entry of this amendment. Notice to this effect is respectfully requested.

§ 112, Second Paragraph Issue:

The final Office Action also rejected claims 4 and 5 under 35 U.S.C. § 112, second paragraph, due to a typographical error in claim 4. Consequently, claim 4 has been amended

herein to correct the noted error. This amendment does not, and is not intended to, narrow or alter the scope of the affected claims.

Following entry of this amendment, all the remaining claims are believed to be in compliance with 35 U.S.C. § 112. In particular, claims 4 and 5 should be in condition for allowance. Notice to that effect is respectfully requested.

Prior Art Issues:

With respect to the prior art, claims 1, 3, 6-9, 11, 15, 31, 32, 36 and 37 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 3,087,364 to Witmer (“Witmer”). Claims 10, 16, 17 and 38-41 were rejected under 35 U.S.C. § 103(a) over Witmer taken alone. For at least the following reasons, this rejection is respectfully traversed.

Claim 1, as amended herein, includes the allowable subject matter of cancelled claim 2 and recites:

An adjustable socket comprising:  
a driver rotatable around a longitudinal axis and having a first end;  
a polygonal recess disposed in said first end of said driver;  
a second recess adjacent said polygonal recess; and  
a stopper disposed in said second recess, said stopper being adjustable so as to extend from said second recess at any of a range of different distances into said polygonal recess;  
wherein said stopper is threaded into said second recess and adjustable into and out of said polygonal recess.  
(emphasis added).

As indicated in the final Office Action, the subject matter of claim 2 is allowable over the prior art without further search or consideration. Consequently, the inclusion of that subject matter in claim 1 should render claim 1 allowable along with its remaining dependent claims, claims 3, 6-10 and 40. Notice to this effect is respectfully requested.

Claim 11 recites:

An adjustable socket operative to rotatably drive a fastener comprising:  
a first recess disposed in said socket receptive of said fastener; and  
an adjustable stopper disposed in a second recess of said adjustable socket for  
limiting penetration of said fastener into said first recess;  
wherein said stopper is adjustable so as to extend into said first recess from  
said second recess at any of a plurality of different distances for selectively limiting  
penetration of said fastener into said first recess.

In contrast, Witmer fails to teach or suggest a stopper that is adjustable so as to extend into said first recess from said second recess at any of a plurality of different distances for *selectively* limiting penetration of said fastener into said first recess. On this point, the final Office Action states that Witmer teaches “a stopper (30) [that] is loosely fitted into the socket body and is thus ‘adjustable’ to various longitudinal positions depending upon the length of the nut fit into the socket. As this is all that is claimed in [claim 11, claim 11] is anticipated by the reference.’ (Action of 2/16/05, p. 4). However, merely being “adjustable” is not all that is called for in claim 11. Claim 11 calls for a stopper that is adjustable to any of a plurality of different distances “for *selectively* limiting penetration of said fastener into said first recess.” (emphasis added).

In contrast, the remover tool (30) taught by Witmer *cannot* “selectively” limit penetration of a fastener into the socket. The final Office Action appears to agree, stating that the Witmer stopper (30) is “loosely fitted into the socket and is thus ‘adjustable.’” (Action of 2/16/05, p. 4). This, however, is *not* a teaching of stopper that can *selectively* limit penetration of a fastener into a socket at any of a plurality of different distances.

Witmer’s “remover tool 30” sits inside a socket (14) to help with the removal of a nut or bolt with edges that are worn and difficult for the socket alone to rotate. When pressed against a nut, the remover tool (30) will always extend the same distance into the socket recess. Otherwise, there will be no friction between the remover tool (30) and the nut.

Consequently, the remover tool (30) of Witmer is not adjustable to selectively limit penetration of the fastener or nut into the recess of the socket as claimed.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, for at least this reason, the rejection of claims 11, 15-17 and 41 based on Witmer should be reconsidered and withdrawn.

Claim 31 recites:

An adjustable socket operative to rotatably drive a fastener comprising: engagement means for engaging said fastener; and stopper means for limiting penetration of said fastener into said engagement means;

wherein said stopper means are adjustable so as to selectively limit penetration of said fastener into said engagement means to any of a plurality of different distances. (emphasis added).

As demonstrated above, Witmer fails to teach or suggest the claimed stopper means that are adjustable so as to *selectively* limit penetration of a fastener into an engagement means to any of a plurality of different distances. Witmer simply fails to teach or suggest any element that is adjustable to allow selective penetration of a fastener into an engagement means over a plurality of different distances.

Again, "[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, for at least

this reason, the rejection of claims 31, 32 and 34-39 based on Witmer should be reconsidered and withdrawn.

Next, claims 18-21 were rejected as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 3,471,160 to Sabo (“Sabo”). For at least the following reasons, this rejection is respectfully traversed.

Claim 18 recites: “A method of tightening or loosening a fastener without damaging a work piece secured with said fastener, said method comprising adjusting a stopper disposed within a socket driver to control an extent to which said fastener is engaged by said driver.”

In contrast, Sabo does not teach or suggest “adjusting a stopper,” as claimed, “to control an extent to which said fastener is engaged by said driver.” Moreover, the final Office Action fails to indicate how or where Sabo teaches a method including “adjusting a stopper.” The Office Action does not cite any teachings from Sabo that a stopper is being adjusted to control the extent to which a fastener is engaged. Claim 18, being a method claim, the cited prior art must teach the method steps recited to anticipate claim 18.

In reality, Sabo never teaches or suggests a method that includes “adjusting a stopper” “to control an extent to which said fastener is engaged by said driver.” Rather, Sabo teaches a method of turning or torquing a pipe (30) without applying a pipe wrench to the exterior of the pipe (30). A section of pipe (32) is screwed onto the threads (43) of the pipe (30) to be turned. A frusto-conical engagement member (20) is then secured in the section of pipe (32) by a plug (44). Sabo does not teach or suggest any “adjustment” of the engagement member (20) or any other member as a stopper to control an extent to which a fastener is engaged. A pipe wrench (31) is then applied to the section of pipe (32) rather than to the pipe (30) to be turned.

Consequently, Sabo does not teach or suggest adjusting a stopper disposed in a socket driver to control an extent to which a fastener is engaged by the driver. There is no discussion in Sabo of controlling the extent to which a fastener is engaged by a driver. Moreover, there is no discussion or suggestion of controlling the engagement of a fastener by adjusting a stopper. Sabo simply does not teach or suggest any of the features of claim 18.

Again, "[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, for at least this reason, the rejection of claims 18-21 based on Sabo should be reconsidered and withdrawn.

Lastly, Claims 10, 16, 17 and 38-41 were rejected under 35 U.S.C. § 103(a) over Witmer taken alone. For at least the following reasons, this rejection is respectfully traversed.

Claims 10, 16, 17 and 38-41 are believed to be patentable over the prior art of record for at least the same reasons as given above with respect to the independent claim from which each depends. Consequently, the rejection of claims 10, 16, 17 and 38-41 should be reconsidered and withdrawn.

Moreover, even though the prior art does not show the features of claims 10, 16, 17 and 38-41, the final Office Action alleges that such features would have been obvious. This is insufficient as a matter of law.

Where the Office relies on a single reference under § 103, it is insufficient to merely state that it would be obvious, or a mere matter of design choice, to modify the disclosure to include the features of the claimed invention. *In re Mills*, 16 USPQ2d 1430, 1432 (Fed. Cir.

1990). "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. (emphasis added). Accord. M.P.E.P. § 706.02(j).

Applicant respectfully requests that prior art references be cited teaching the subject matter of claims 10, 16, 17 and 38-41 or the rejection of those claims be withdrawn.

Conclusion:

Entry and consideration of this amendment are proper under 37 C.F.R. § 1.116 for at least the following reasons. The present amendment makes only those changes necessary to place various claims in condition for allowance as indicated by the Examiner and/or to place the application in better form for appeal. The amendment does not introduce new subject matter to the claims and, therefore, does not raise new issues requiring further search or consideration. Therefore, entry of the present amendment is proper under 37 C.F.R. § 116 and is hereby requested.



For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

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